

ADVANCED PATENT ISSUES AND ACCELERATED EXAMINATION

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Overview

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- **Quick Review of Claim Basics**
- **Preparing for Claim Drafting**
- **Claim Drafting – Practicing the Art (one perspective)**
- **Prioritized Examination**

Quick Review of Basics

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Claim Overview

- **Claims:** define the legal boundary of the invention (*i.e.*, “metes and bounds”)
- **35 U.S.C. § 101** (Statutory Classes): Process, machine, (article) manufacture, or composition or matter, or any new and useful improvement thereof
- **35 U.S.C. § 112, 1st paragraph:** written description and enablement
- **35 U.S.C. § 112, 2nd paragraph:** the specification shall conclude with one or more claim particularly pointing out and distinctly claiming the invention

Quick Review of Basics (cont.)

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Claim Structure

- **Preamble (Tip):** Introductory section indicating the statutory class of the invention
- **Transition phrase:** Word between the preamble and the claim body
- **Body:** Recites the elements of the claim and describes how they cooperate structurally, physically, or functionally to form an operative invention

Quick Review of Basics (cont.)

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Claim Types

- System
- Structure/apparatus
- Method of use
- Method of manufacture
- Computer Program Product
- Software Product
- Means-plus-function
- Method of Doing Business

Preparation – Initial Inventor Interview

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- Understanding the invention (...measure twice, cut once)
 - ▣ Carefully prepared questions – claim drafting perspective
 - ▣ Must also understand client’s business focus – product coverage, litigation, or licensing?
 - ▣ Forcing inventor to disclose “unique contribution, or patentable language”

- Memorializing the Interview
 - ▣ Video/audio recording
 - ▣ Digital photos of white board drawings



----- **Invention, as described by inventor**



----- **Invention, as understood by patent attorney**



----- **Invention, as originally claimed**



----- **Amended claim**



----- **Allowed claim**



----- **Actual invention**

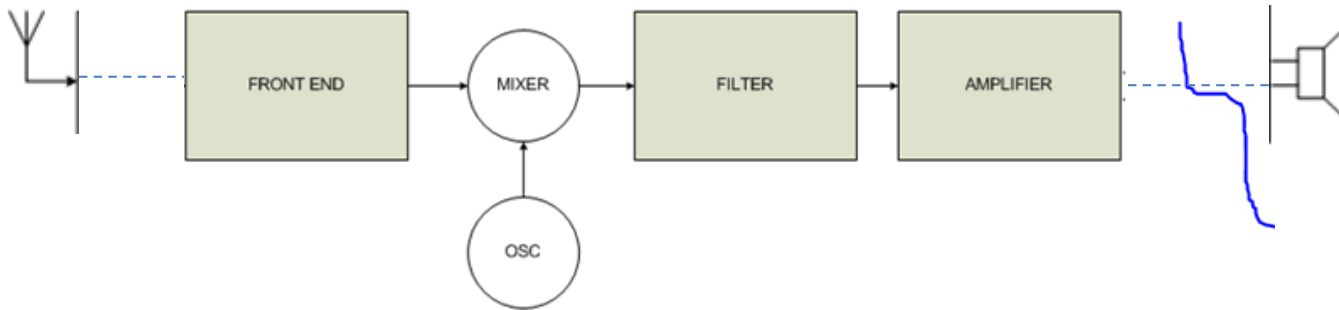
Preparation – Initial Inventor Interview (cont.)

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- Producing a “rough” draft claim at conclusion of interview
 - ▣ Maximizes understanding of invention
 - ▣ “Connected” or “connectable?”
 - ▣ Achieves early claim buy-in from inventor
 - ▣ Uses inventor’s terminology

Preparation - Interview (cont.)

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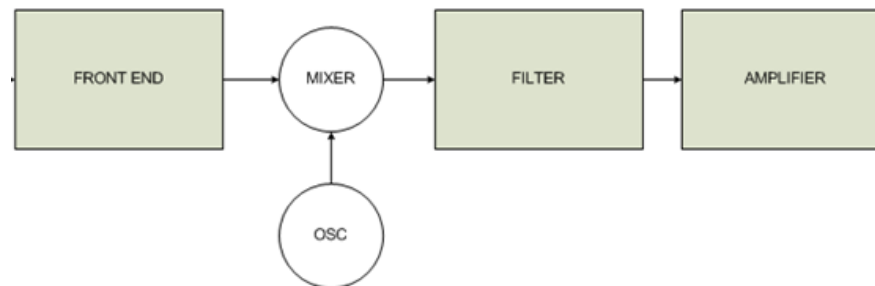
Inventor and attorney:

“.... a signal processing system using components A, B, C, and D, along with a standard oscillator, that produces a constantly downwardly sloping enable signal. The system avoids use of a phase lock loop, all components being on a single substrate”

Practicing the Art (claim drafting)

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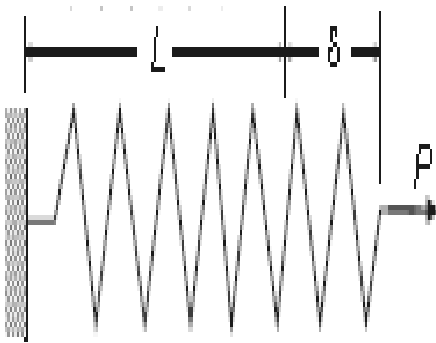
1. A signal processing system, comprising:
a front end;
an oscillator;
a mixer;
a filter; and
an amplifier



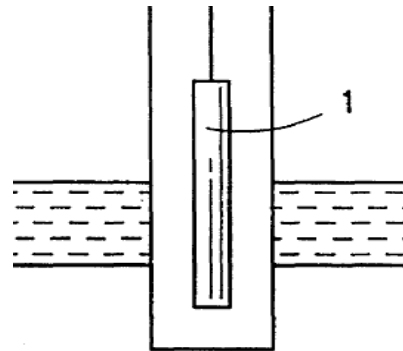
Claim drafting (cont.)

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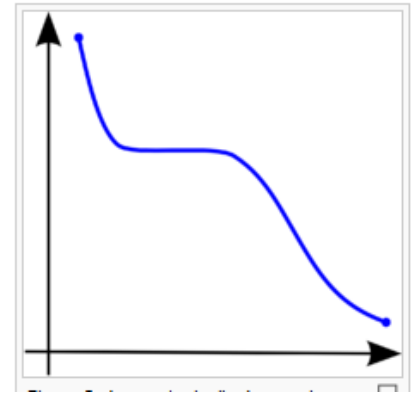
Claim Terminology Cheat Sheet



axially loaded member



longitudinally disposed workpiece



monotonically decreasing waveform

Claim drafting (cont.)

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1. A signal processing system, comprising:
 - a front end (**at least one from the group including a receiver and a front end processor**) arranged to receive a signal (**received from an antenna**)(**received in accordance with Bluetooth standards**);
 - an oscillator (**banded isolator or crystal oscillator**)(**only one oscillator**) arranged to generate in oscillation signal;
 - a mixer arranged to mix a signal from the front and with the oscillation signal and provide some in different signals and an output thereof;
 - a filter for filtering out the sum signal; and
 - an amplifier for amplifying the difference signal and producing an output signal therefrom (**monotonically decreasing signal**)(**connectable to an audio speaker**)(**devoid of a phase lock loop oscillator**)(**on a single substrate**).

Claim drafting (cont.)

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- Almost finished:
 - Focus and fine tune only one independent claim initially
 - Facilitates more streamlined claim drafting - simultaneously drafting independent and dependent claims

- Other claim drafting considerations
 - Perform word search of all claim terms to ensure adequate written description support
 - Understanding whether client is “product coverage” focused, litigation, and/or “licensing” focused
 - Client Focus drives claim strategy
 - Claim and describe alternative, discarded, and or potential competitor approaches – inventors are often “specific implementation” focused

Claim drafting (cont.)

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- Other claim drafting considerations
 - ▣ After fine tuning independent claim, work backwards
 - Hide formal drawing – then graph claim to ensure accuracy
 - Purposes of clarity and elimination of unnecessary limitations
 - ▣ Keep dictionary handy
 - ▣ Stay abreast of relevant case law

Prioritized Examination – Facts

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- Track 1 Accelerated Examination
 - ▣ Track 2: Normal Examination
 - ▣ Track 3: Delayed Examination
- Final Disposition from USPTO with 12 months
 - ▣ First office action in 3-4 months
- \$4800.00 (\$2400.00 for small entity)
- No prior art search by Applicant

Prioritized Examination – Benefits

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- Facilitates rapid creation of patent portfolios
 - ▣ Granted patent more valuable than pending application
- Although filing fee required, potential cost savings to Applicant due to streamlined prosecution
- Quick reaction tool for filing continuation claims on potentially infringing products
- Potential for minimizing prosecution history estoppel

Summary

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- **Claim Basics**
- **Preparing for Claim Drafting**
- **Claim Drafting – Practicing the Art (one perspective)**
- **Accelerated Examination**

Questions?

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